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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/582,483	06/21/00	KUBAYASHI	AD-6547-A

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EXAMINER
SHOSHO, C

ART UNIT	PAPER NUMBER
1714	5

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/582,483

Applicant(s)
Kobayashi

Examiner
Calle Shosho

Art Unit
1714



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirements.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☒ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 20) ☐ Other: _____

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DETAILED ACTION

Specification

1. This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 8 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 01245045.

Pending translation of the Japanese reference, it is noted that the JP 01245045 discloses a molding composition comprising ABS resin, polyether esteramide, ion source such as stearate or laurate of calcium, magnesium, and zinc, and plasticizer.

In light of the above, it is clear that JP 01245045 anticipates the present claims.

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Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claims 1-2 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ueda et al. (U.S. 5,886,098).

Ueda et al. disclose an antistatic composition 3-40% polyetherester amide, 60-90% polymer such as polyamide, polycarbonate, polyacetal, and polyester, 0.2-20% ion source such as alkali metal or alkaline earth metal salt of sulfonic acid, and plasticizer wherein the composition has surface resistivity on the order of 10^{10} - 10^{11} (col.1, lines 14-15, col.2, lines 25 and 35-42, col.5, lines 7-19, col.6, lines 59-67, col.7, lines 38-53, col.8, lines 1-8 and 22-34, col.11, lines 22-32, col.12, line 19, col.15, lines 45-55, and Tables 7 and 10).

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While Ueda et al. does not exemplify the antistatic composition as presently claimed nor can the claimed antistatic composition be "clearly envisaged" from Ueda et al. as required to meet the standard of anticipation (cf. MPEP 2131.03), nevertheless, in light of the overlap between the claimed antistatic composition and the molding composition disclosed by Ueda et al., it is urged that it obvious that it would have been within the bounds of routine experimentation, as well as the skill level of one of ordinary skill in the art, to utilize an antistatic composition which is both disclosed by Ueda et al. and encompassed within the scope of the present claims, and thereby arrive at the claimed invention.

6. Claims 3-4 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ueda et al. as applied to claims 1-2 and 5 above, and further in view of either Mukohyama (U.S. 5,700,857) or Brink et al. (U.S. 5,624,987).

The difference between Ueda et al. and the present claimed invention is the requirement in the claims of specific type and amount of plasticizer.

Mukohyama, which is drawn to resin composition, disclose the use of 0.1-10% plasticizer identical to that presently claimed, such as polyethylene glycol di-2-ethyl hexoate, in order to maintain the mechanical characteristics of the composition and control crystallization rate and molding temperature of the composition (col.3, lines 17-50).

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Alternatively, Brink et al., which is drawn to plasticizers, disclose the use of 0.5-25% plasticizer identical to that presently claimed such as polyethylene glycol bis(2-ethyl hexanoate), in order to improve moldability (col.1, lines 42-45 and col.4, lines 7-38).

In light of the motivation for using specific type and amount of plasticizer disclosed by either Mukohyama or Brink et al. as described above, it therefore would have been obvious to one of ordinary skill in the art to use such plasticizer in the antistatic composition of Ueda et al. in order to produce a composition with good mechanical properties and suitable crystallization rate and molding temperature, or alternatively, a composition with good moldability, and thereby arrive at the claimed invention.

7. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ueda et al. as applied to claims 1-2 and 5 above, and further in view of JP 01163252.

The difference between Ueda et al. and the present claimed invention is the requirement in the claim of specific type of molded article.

Ueda et al. disclose that the antistatic composition is used in molded articles but there is no explicit disclosure that the molded article is a transfer medium-separating guide part for electrophotographic devices.

On the one hand, given the broad disclosure of antistatic molded articles by Ueda et al., it would have been obvious to one of ordinary skill in the art to use such molded article in any

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device which required antistatic properties including transfer medium-separating guide part for electrophotographic devices, and thereby arrive at the claimed invention.

On the other hand, JP 01163252 disclose that antistatic compositions comprising polymer such as polycarbonate and polyetherester amide are used in copiers and for parts of electric appliances and machines, which clearly encompasses transfer medium-separating guide part for electrophotographic devices.

In light of the disclosure of JP 01163252, it therefore would have been obvious to one of ordinary skill in the art that the antistatic composition of Ueda et al. can in fact function as transfer medium-separating guide part for electrophotographic devices, and thus, one of ordinary skill in the art would have arrived at the claimed invention.

8. Claims 8 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ueda et al. (U.S. 5,886,098).

Ueda et al. disclose an antistatic composition polyetherester amide, polymer such as ABS and EPDM, ion source such as alkali metal or alkaline earth metal salt of sulfonic acid, and plasticizer wherein the composition has surface resistivity on the order of 10^{10} - 10^{11} (col.1, lines 14-15, col.2, lines 25 and 35-42, col.5, lines 7-16 and 67, col.6, lines 5-6 and 59-67, col.7, lines 38-53, col.8, lines 1-8 and 22-34, col.11, lines 22-32, col.12, line 19, col.15, lines 45-55, and Tables 7 and 10).

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While Ueda et al. does not exemplify the antistatic composition as presently claimed nor can the claimed antistatic composition be "clearly envisaged" from Ueda et al. as required to meet the standard of anticipation (cf. MPEP 2131.03), nevertheless, in light of the overlap between the claimed antistatic composition and the molding composition disclosed by Ueda et al., it is urged that it obvious that it would have been within the bounds of routine experimentation, as well as the skill level of one of ordinary skill in the art, to utilize an antistatic composition which is both disclosed by Ueda et al. and encompassed within the scope of the present claims, and thereby arrive at the claimed invention.

9. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ueda et al. as applied to claims 8 and 10 above, and further in view of Buysch et al. (U.S. 4,920,166).

The difference between Ueda et al. and the present claimed invention is the requirement in the claim of water-repellant.

Buysch et al., which is drawn to molding composition, disclose the use of polytetrafluoroethylene in order to improve surface molding and prevent dripping of the molding composition in the event of fire (col.7, line 47-col.8, line 17). Given that the polytetrafluoroethylene is identical to that presently claimed, it would have been natural for one of ordinary skill in the art to infer that it intrinsically functions as a water-repellant.

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In light of the above, it therefore would have been obvious to one of ordinary skill in the art to use polytetrafluoroethylene in the antistatic composition of Ueda et al. in order to produce a composition with improved molding, and thereby arrive at the claimed invention.

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Fukumoto et al. (U.S. 5,500,478) disclose a molding composition comprising thermoplastic resin, polyetherester amide, and ion source identical to (i) presently claimed, but there is no disclosure of ion source corresponding to (ii) presently claimed.

Ohkawa et al. (U.S. 4,891,399) disclose molding composition comprising metallic filler coated with water-repellant such as silicone.

Alex et al. (U.S. 6,018,015) disclose antistatic composition comprising polyetherester amide, thermoplastic polymer, and salt of ethylene/methacrylic acid resin, however, there is no disclosure of plasticizer as presently claimed.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Callie Shosho whose telephone number is (703) 305-0208. The examiner can normally be reached on Monday-Thursday from 7:00 am to 4:30 pm. The examiner can also be reached on alternate Fridays.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on (703) 306-2777. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3599.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

CS.

Callie Shosho
5/8/01

Vasu Jagannathan
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